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10/779,492

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EXAMINER

MULCAHY, PETER D

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Please find below and/or attached an Office communication concerning this application or proceeding.

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 10/779,492
Filing Date: February 13, 2004
Appellant(s): HE ET AL.

Sun Hee Lehmann
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 8/16/10 appealing from the Office action mailed 3/15/10.

(1) Real Party in Interest

The examiner has no comment on the statement, or lack of statement, identifying by name the real party in interest in the brief.

(2) Related Appeals and Interferences

The following are the related appeals, interferences, and judicial proceedings known to the examiner which may be related to, directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal:

Serial No. 10/779,505 is currently awaiting decision by the Board of Appeals.

(3) Status of Claims

The following is a list of claims that are rejected and pending in the application:

1-4, 6-9, 11-14, 16 and 17

(4) Status of Amendments After Final

The examiner has no comment on the appellant's statement of the status of amendments after final rejection contained in the brief.

(5) Summary of Claimed Subject Matter

The examiner has no comment on the summary of claimed subject matter contained in the brief.

(6) Grounds of Rejection to be Reviewed on Appeal

The examiner has no comment on the appellant's statement of the grounds of rejection to be reviewed on appeal. Every ground of rejection set forth in the Office action from which the appeal is taken (as modified by any advisory actions) is being maintained by the examiner except for the grounds of rejection (if any) listed under the

subheading "WITHDRAWN REJECTIONS." New grounds of rejection (if any) are provided under the subheading "NEW GROUNDS OF REJECTION."

(7) Claims Appendix

The examiner has no comment on the copy of the appealed claims contained in the Appendix to the appellant's brief.

(8) Evidence Relied Upon

5939483	Kueppers	8-1999
5292819	Diehl et al.	3-1994

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-4, 6-9, 11-14, 16 and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kueppers US 5,939,483 in view of Diehl et al. US 5,292,819.

The claims are directed to "hot melt adhesive comprising
a radial block copolymer component comprising (PS-PI)_nX wherein PS is polystyrene and PI is polyisoprene, X is the residue of a multifunctional coupling agent used in the production of the radial block copolymer, and n is equal to or greater than 3

Art Unit: 1762

and represents the number of PS-PI arms appended to X, and wherein the styrene content of the radial block

copolymer is from 25 wt % to about 50 wt % a linear triblock copolymer, a tackifying resin, and, a liquid plasticizer, wherein, based on the weight of the adhesive composition, the said radial block copolymer component is present in amounts of less than 15 wt %, the linear triblock is present in amounts up to about 20 wt %, the tackifying resin is present in amounts of from about 30 to about 70 wt %, and the plasticizer is present in amounts of from about 10 wt % to about 20 wt %, said adhesive being suitable for use as an elastic attachment adhesive.”

Kueppers is cited as showing hot melt adhesives comprising applicants (PS-PI) X. This component is suggested to be used in amounts ranging 10-40%, see column 4 lines 25-50. This patent further shows the claimed triblock polymer in amounts of 0 to 20%, see column 6 lines 10-15. Tackifiers and plasticizers as claimed are discussed at column 4 lines 66+ and column 7 lines 4+. Further, the tackifiers are suggested to be used in amounts of 10% to 40%, column 6 lines 60-65, and plasticizers are suggested to be used in amounts of 0 to 25%, column 7 lines 48-49. The difference between the claimed invention and the Kueppers teaching is that Kueppers lacks an anticipatory example. The disclosure suggests each of the claimed ingredients and the amounts taught in the disclosure of the patent overlap those as claimed. It is well established that overlapping range values are prima facie obvious. One is directed to select the ingredient and use it in the claimed amount. As such the composition is rendered prima facie obvious.

The claims on appeal further recite that the adhesive composition be "suitable for use as an elastic attachment adhesive". This is an intended use and a mental step. As such, it is questionable just how this language further limits the claim. In the event that the limitation is seen to positively limit the claim, then it is maintained that the adhesive shown in Kueppers is "suitable for use as an elastic attachment adhesive". In any event, the intended use of the adhesives discussed in Kueppers is in packaging applications.

Diehl et al. is cited as showing very similar adhesive compositions. These compositions comprise the claimed block polymers, tackifiers and plasticizers, see the abstract. This patent further discusses various end uses for the adhesives disclosed therein. Column 6 lines 5-30 specifically identify the use of the adhesive being diaper applications, packaging and carton sealing. One having ordinary skill in the art would have a clear understanding that adhesives useful in packaging applications can be used in diaper and elastic attachment as well. One would be motivated to select the adhesive compositions in Kueppers for elastic attachment applications as shown in Diehl, given the art recognized properties that make these adhesives suitable for both packaging and elastic attachment as evidenced by the disclosure in Diehl.

(10) Response to Argument

Appellant extensively argues that the Kueppers adhesive is used in packaging application. It is alleged that the limitation "suitable for use as an elastic attachment adhesive" is not met. It is well established that a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior

Art Unit: 1762

art. If the prior art structure is capable of performing the intended use, then it meets the claim. There is no reason to understand that the adhesive of Kueppers is not "suitable for use as an elastic attachment adhesive".

It is then argued that the viscosity reported in Kueppers is such that the adhesive composition would be unsuitable for the elastic attachment as claimed. This can not be found persuasive. There is no claim limitation relative to the viscosity. The viscosity feature upon which applicant relies is not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Kueppers reports viscosities as high as 5000cPs and directs one to use lower viscosities for packaging applications. Implicit within this disclosure is that the viscosity property is well known and the manipulation thereof is well within the skill of one in the art. It is prima facie obvious to arrive at optimum proportions so as to provide desired properties. Appellant has provided no proof that Kueppers' adhesives have unsuitable viscosity for use as an elastic attachment adhesive, and in any case, viscosity is a function of temperature. Appellants' claims are not drafted in such a manner so as to patentably distinguish from the compositions of Kueppers. One having ordinary skill would have been motivated to manipulate the compositions so as to render the adhesive suitable for elastic attachment as well as packaging.

Art Unit: 1762

Appellant separately argues claim 17. Claim 17 is not separately patentable from claim 1. Appellant advances the same arguments as for claim 1 and the examiners answer to these arguments applies to claim 17.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

/Peter D. Mulcahy/

Primary Examiner, Art Unit 1762

Conferees:

/David Wu/

Supervisory Patent Examiner, Art Unit 1796

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Supervisory Patent Examiner, Art Unit 1765